

- 3 -

09/599,679

REMARKS

Applicant appreciates the telephone interviews granted by the Examiner to Applicant's undersigned attorney. In that interview, the Examiner indicated that he would invoke the interference action requested by the Applicant and that claims 30 and 31 would be allowed if claim 30 was amended as indicated herein. During the interview, the undersigned agreed to cancel claim 26, amend claim 30 as indicated, and submit a second supplemental reissue declaration.

Reissue Application

The Office Action states that the original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, **must** be received before this reissue application can be allowed. See 37 CFR 1.178

Applicant's Response

The original patent will be surrendered before the prosecution of the present case comes to an end.

Election/Restriction

New claim 26 was found to be directed to an invention that is independent or distinct from the invention originally claimed and was withdrawn from consideration as being directed to a non-elected invention, pursuant to 37 CFR §1.142(b) and MPEP §821.03.

Applicant's Response

Claim 26 has been cancelled, without prejudice or disclaimer.

Reissue Declaration

The supplemental reissue declaration filed October 15, 2002 was found to be acceptable.

Applicant's Response

Pursuant to the Examiner's direction, a second supplemental reissue declaration is being filed with this paper.

- 4 -

09/599,679

Drawings

The drawings were objected to under 37 CFR 1.83(a). The Office Action states:

The drawings must show every feature of the invention specified in the claims.

Therefore, the outermost row of cleats "disposed immediately adjacent" the periphery of the drum as set forth in claim 30 must be shown or the feature canceled from the claim.

Applicant's Response

Claim 30 has been amended to delete the term "immediately". Therefore, it is submitted that this objection is overcome by the amendment of claim 30 and no amendment to the drawings is now necessary. Accordingly, the objection under 1.83(a) should be withdrawn.

Specification

The specification was objected to under 37 CFR 1.75(d)(1) as failing to provide antecedent basis for the claimed subject matter. In particular, the Office Action states:

There is no description and therefore no support for the limitation of the outermost rows of teeth being disposed "immediately adjacent" the outer periphery of the cylindrical drum as set forth in lines 8 and 9 of new claim 30.

Applicant's Response

Claim 30 has been amended to delete the word "immediately". Therefore, it is submitted that the present specification now provides proper antecedent basis for the subject matter of claim 30. Accordingly, the objection under §1.75(d)(1) should be withdrawn.

Rejection of Claims 30 and 31 under USC § 112

Claims 30 and 31 were rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Office Action further states:

Since the specification is silent on the definition of the term "immediately adjacent" as used in claim 30, one of ordinary skill in the art would not be enabled to make and/or use the claimed invention because it is not clear where the outermost row of teeth or cleats should be disposed.

Claims 30 and 31 were also rejected under 35 USC 112, first paragraph, as containing

- 5 -

09/599,679

subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Office Action further states:

The disclosure as originally filed does not include any description of the outermost row of cleats or teeth being disposed "immediately adjacent" the outer periphery of the drum of the wheel as now claimed in newly presented claim 30.

Claims 30 and 31 filed with the amendment of October 15, 2002 have been copied from United States Patent No. 5,687,799. These claims are not patentable to Applicant because Applicant cannot show support for the claims in the specification as originally filed as explained ... above.

Applicant's Response

Claim 30 has been amended to delete the term "immediately" therefrom. Accordingly, it is submitted that these §112 rejections should be withdrawn and claims 30 and 31 allowed.

Interference

Claims 30 and 31 were rejected under 35 USC 135(b) as not being made prior to one year from the date on which U.S. Patent No. 5,687,799 ('799) was granted. See *In re McGrew*, 120 F.3d 1236, 1238, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997) where the Court held that the application of 35 USC 135(b) is not limited to *inter partes* interference proceedings, but may be used as a basis for *ex parte* rejections.

Applicant's Response

It is respectfully submitted that there is no requirement that, in order to invoke an interference action, an Applicant has to copy a claim of the other party. MPEP §2306 states: "An interference may be declared between an application and a patent if the application and patent are claiming the same patentable invention, as defined in 37 CFR 1.601(n), and at least one of the applicant's claims to that invention are patentable to the applicant." Applicant submits that claims 30 and 31, as amended herein, are no longer copies of claims found in U.S. Patent No. 5,687,799 and are patentable over the art of record. It is also submitted that the structural distinction raised in previous Office Actions to deny the initiation of an interference action, namely that in the '799 claims the axially outermost row of cleats are positioned "immediately adjacent" the outer periphery of the drum, does not provide any patentable distinction between

- 6 -

09/599,679

amended claims 30 and 31 and the invention claimed in the '799 patent, as required by 37 CFR 1.601(n).

Accordingly, it is respectfully requested that the Examiner initiate an interference proceeding between the present case and the '799 patent based, at least in part, on amended claims 30 and 31.

Allowable Subject Matter

Applicant acknowledges and appreciates the finding, in the Office Action, that claims 1-23, 25 and 29 are allowable over the prior art of record.

CONCLUSION

For the foregoing reasons, applicant respectfully submits that claims 1-23, 25, 26 and 29-31, as amended herein, are in condition for allowance. It is submitted that no new matter has been added by any of the amendments. In addition, claims 1-10 in the '799 patent are directed to subject matter that is patentably indistinct from at least the present claims 30 and 31. An interference based on the proposed counts is therefore appropriate.

Respectfully submitted,

Date: 3/14/03

By: Harold C. Knecht, III
Harold C. Knecht, III
Registration No. 35,576

P.O. Box 28338
St. Paul, MN 55128
Telephone: (651) 575-1056

/HCK

- 7 -

09/599,679

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Applicant: Robert J. Brockway

Filed: June 22, 2000

Title: COMPACTOR WHEEL AXLE
GUARD SYSTEM

Examiner: R. Stormer

Group Art Unit: 3617

Serial No.: 09/599,679

Atty Docket No.: TER003RA

Commissioner for Patents
Washington, DC 20231

Sir:

Version With Markings to Show Changes Made

Applicant provides the following marked up versions of claim 30 that was amended in Applicant's March 14, 2003 Amendment and Response filed in response to the Final Office Action mailed November 5, 2002. In the amendments below, [brackets] are used to show where terms were removed from the claims, while underlines are used to show where terms were added to the claims.

Please amend claim 30 as follows:

30. (Amended) A wheel assembly for a compacting machine having a frame and a pair of axle assemblies mounted to the frame, comprising:

a cylindrical drum mountable for rotation on each of an opposing end of at least one of the axle assembly, said cylindrical drums being positioned on opposite sides of the frame, each of said cylindrical drums defining an inner periphery adjacent the frame and an outer periphery:

a plurality of teeth disposed circumferentially about each of the cylindrical drums, said teeth extending outwardly from the cylindrical drums a preselected distance and being disposed in a plurality of axially spaced rows with the outermost of said rows being positioned [immediately] adjacent the outer periphery of [the] each cylindrical drum and the innermost of said rows being spaced from the inner periphery a preselected distance.